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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,484	09/04/2003	Takayuki Ogino	9333/353	5870
74980	7590	07/16/2008	EXAMINER	
ALPINE/BHGL			DURAN, ARTHUR D	
P.O. Box 10395			ART UNIT	
Chicago, IL 60610			PAPER NUMBER	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/655,484

**Applicant(s)**

OGINO ET AL.

**Examiner**

Arthur Duran

**Art Unit**

3622

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 7-13, 16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-13, 16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-4, 7-13, 16, 18-20 are examined.

#### ***Response to Amendment***

The Amendment filed on 6/17/2008 is insufficient to overcome the prior rejection.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/17/08 has been entered.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-4, 11-13, 16, and 18-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkman (US 2002/0013728 A1) in view of Tomita (20040054586).
2. Regarding claims 1, 11, and 16, Wilkman teaches of a system and method "for providing transaction control for purchasing decisions that involve the use of credits,

debits, loyalty points, affinity points, promotions, or currency transfers.” (Abstract). In particular, Wilkman teaches of obtaining user information (Fig. 5; [0102]-[0106]) and loyalty information related to the user ([0066]; [0110]). Thereafter, a query is done for merchants who satisfy various factors, one of which is number of loyalty points. ([0110]; [0113]). The system then displays merchant information and their related promotion for merchants that match the criteria (i.e. number of points). ([0116]-[0118]).

Wilkman further discloses that queries for services available related to user points can be made ([110,113]).

Wilkman does not explicitly disclose searching for only an available facility which offers a point service available to the user within said cumulative number of points.

However, Tomita discloses searching for only an available facility which offers a point service available to the user within said cumulative number of points ([215, 284]; claim 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Tomita’s more searching for only facilities with services for available points to Wilkman’s searching for facilities related to points. One would have been motivated to do this in order to provide facilities/services which are of interest to the user.

Additionally, Wilkman teaches of a system and method for a user being able to search for merchants that satisfy a certain requirement, such as loyalty points. (Wilkman, [0110]; [0113]). Wilkman teaches that a user can select a specific merchant/promotion in order to find further details related to that merchant/promotion.

(Wilkman, [0118]). Furthermore, Wilkman explicitly teaches of a “map feature that presents the user with a map of the location of the service as well as other information.”

(Wilkman, [0129]). Additionally, Wilkman teaches that the system can be used on any portable device, such as a cell phone or personal digital assistant (PDA). Wilkman further teaches of utilizing GPS and location information ([41, 128, 135]) and Wilkman discloses presenting map information, driving distance and travel time information from the user's current location to points of interest ([129]).

Wilkman does not explicitly teach of the system providing guidance by guiding a vehicle to the merchant.

However, given the above use of GPS, map information, driving distance, and travel time to a point of interest, it is obvious to one skilled in the art that Wilkman can provide routing or direction information. One would be motivated to do this because directions are an obvious extension of a map, driving distance, and travel time and further assist the user in arriving at the point of interest.

Alternatively, please see the rejection below further utilizing Smith.

3. Regarding claims 2, 12, and 18, Wilkman teaches that the user can click on a promotion to find detailed information about the merchant, such as “driving distance, travel time, photo of location, photo of building, sample menu, list of prices, dining ratings, and so forth.” ([0118]; [0129]).

4. Regarding claim 3-4, 13, 19-20, Wilkman teaches of storing promotion information related to merchants in a searchable database accessible to the user.

([0063], [0064]). Wilkman further teaches that the user can search and sort merchants and promotions based on the "number of loyalty points". ([0110], [0113]).

5. Claims 1-4, 11-13, 16, and 18-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkman (US 2002/0013728 A1) in view of Tomita (20040054586) in view of Smith (US 6,314,365).

Regarding claims 1, 11, 16, please see the above.

Additionally, Wilkman teaches of a system and method for a user being able to search for merchants that satisfy a certain requirement, such as loyalty points. (Wilkman, [0110]; [0113]). Wilkman teaches that a user can select a specific merchant/promotion in order to find further details related to that merchant/promotion. (Wilkman, [0118]). Furthermore, Wilkman explicitly teaches of a "map feature that presents the user with a map of the location of the service as well as other information." (Wilkman, [0129]). Additionally, Wilkman teaches that the system can be used on any portable device, such as a cell phone or personal digital assistant (PDA). Wilkman further teaches of utilizing GPS and location information ([41, 128, 135]) and Wilkman discloses presenting map information, driving distance and travel time information from the user's current location to points of interest ([129]).

Wilkman does not explicitly teach of the system providing guidance by guiding a vehicle to the merchant.

However, given the above use of GPS, map information, driving distance, and travel time to a point of interest, it is obvious to one skilled in the art that Wilkman can provide routing or location information. One would be motivated to do this because directions are an obvious extension of a map, driving distance, and travel time and further assist the user in arriving at the point of interest.

As a further example of this, Smith teaches of a system and method for providing guidance to a vehicle using a users cell phone. (Smith, Abstract). In particular, Smith teaches that the user enters a destination into the cell phone (merchant destination) and the cell phone provides directions and a map to the user in a vehicle. (Smith, Fig. 1; Col 1, Lines 65-67; Col 2, Lines 1-61). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have added to Wilkman's teaching of a system on a cell phone for providing merchant information (including a map) based on a user's query with Smith's teaching of a cell phone that is used to navigate a vehicle to a desired location. One would have been motivated to do so because a navigational system is a known upgrade to a map based directional system.

Regarding claims 2, 12, and 18, please see the rejection above.

Regarding 3-4, 13, 19-20, please see the rejection above.

**6. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkman (US 2002/0013728 A1) in view of Tomita (20040054586) in view of Mizuishi et al. (JP 2002230696 A -- 8/16/2002).**

**7. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkman (US 2002/0013728 A1) in view of Tomita (20040054586) in view of Smith (US 6,314,365) in view of Mizuishi et al. (JP 2002230696 A -- 8/16/2002).**

Please see the rejections above.

8. Regarding claims 7-10, Wilkman teaches of a system and method whereby a user enters in personal information, searches for a merchant/promotion based on various factors, is displayed a list of eligible merchants, and is given subsequent information related to merchant/promotion. (Wilkman, Abstract; [0110]; [0113]; [0118]; [0129]). Furthermore, Wilkman teaches that the system manages, tracks, and grants reward points. (Wilkman, [0110]; [0125]-[0126]).

Wilkman further discloses managing at least two different types of points ([135]).

Wilkman does not explicitly teach of awarding points to a user based on their driving activities. However, Mizuishi et al. teaches of a system and method for awarding points to a user based on characteristics of their actual driving. (Abstract). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have added to Wilkman's point management system with Mizuishi et al.'s teaching of awarding points based on driving. One would have been motivated to combine the references because Wilkman teaches of a method for managing points while Mizuishi et al. teaches of a method for obtaining points.



***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are not found persuasive.

In regards to the route or directions features added to claim 1, these were rejected in the Final Rejection dated 4/24/08 utilizing the Smith reference. Hence, these features have been priorly addressed and rejected. Hence, please see the two rejections above which address the route or directions providing feature.

In regards to claim 7, and the managing of at least two different types of points, Wilkman further discloses managing at least two different types of points ([135]).

Also, Examiner notes that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In interpreting claim language, the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art is applied, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded

by the written description. See *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). See also *In ream. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) and *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983). Claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000). It is Appellant's burden to precisely define the invention. See *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997).

Examiner notes that "Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007).

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.

If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, §103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the

technique is obvious unless its actual application is beyond that person's skill. KSR Int'l Co. v. Teleflex, Inc., No 04-1350 (U.S. Apr. 30, 2007).

Also, KSR states that "the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."

KSR, 127 S.Ct. at 1739 and 1741, 82 USPQ2d at 1396.

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Yoshioka (20020004730) discloses searching for services related to cumulative points available ([33]); b) Sato (20030128391) discloses searching for services related to cumulative points available ([48]).

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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7/14/08